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EXAMINER

AUVE, GLENN ALLEN

ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 24

Application Number: 09/224,620
Filing Date: December 31, 1998
Appellant(s): MARISSETTY, SURESH K.

Jeffrey S. Draeger
For Appellant

MAILED

FEB 05 2003

Technology Center 2100

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 5, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because appellant's invention as disclosed is a power management mechanism wherein a power management virtual device driver (PMVxD) is responsible for device idle detection and performs that idle detection using event timers that provide an indication of the activity level. The virtual device driver places idle local devices in a reduced power consumption state when no activity has occurred for a predetermined period of time (as is outlined in the abstract of the disclosure and see also col. 4, line 65 – col. 5, line 17). The entire disclosure is directed to this power management virtual device driver and the way in which it is operated to control the devices. Appellant's summary of the invention attempts to describe the invention somewhat more broadly.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. However, only issues 3-13 really deal with the claim rejections which would seem to be appropriate issues for decision by the Board. Issues 1,2, and 14 appear to be legal questions which seem to be beyond the scope of the appeal. Certainly issues 1 and 2 are part of appellant's arguments with regard to issues 3-13 which deal with the claim rejections, and as such they will be treated with respect to the claim rejections.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 51-94 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). While the only real issue in the case is that of whether impermissible recapture exists in the claims, appellant has chosen to group the claims and argue the groups separately. Generally speaking the same issues exist with regard to every group. The groups are treated as set forth by appellant.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 51-94 are rejected under 35 U.S.C. 251. This rejection is set forth in prior Office Action, Paper No. 19, which is attached as an appendix to this Examiner's Answer.

Claims 1-35 and 51-94 are also still rejected under 35 U.S.C. 251 as being based upon a defective reissue declaration as set forth in prior Office Action, Paper No. 19. Appellant has not provided a signed version of the new reissue declaration which remedies the defects outlined in the prior action.

(11) Response to Argument

Issue 1. Does the recapture doctrine bar any broadening of a claim beyond a limitation that was added to overcome a prior art rejection, meaning that the reissue claim may not exclude the precise limitation that was added to overcome the prior art in the original patent?

As noted above, this is really not an "issue" in itself to be decided here. The question of this issue is treated with respect to the claim rejections in issues 3-13 to follow.

Issue 2. Did applicant "surrender" any and all subject matter that lacks the "virtual device driver" limitation?

As noted above, this is really not an "issue" in itself to be decided here. The question of this issue is treated with respect to the claim rejections in issues 3-13 to follow.

Issue 3. Does the recapture doctrine bar the claims of Group I (51,57,86,87,89)?

Appellant argues that the differences between original claim 11 and reissue claim 51 are material, and that this alleged material narrowing allows the claim to avoid recapture.

When determining whether recapture exists various test have been devised by the courts. The facts in Pannu and Clement appear to be most relevant to the facts in the present case. Those courts developed what are basically three part tests for determining whether or not recapture exists. First, did applicant broaden the claims; secondly, if so, is the broadening related to what was surrendered during prosecution of the patent; and third, have the claims also been materially narrowed. In the present case the disagreement appears to lie in the question of whether or not the new limitations are materially narrowing or not.

The original or “surrendered” claim recites the use of a device driver for controlling power to various devices. The newly presented reissue claims do not include limitations drawn to the device driver or the virtual device driver limitation which was added in the amendment in order to make the patent claims allowable. Appellant freely added the virtual limitation to the claim and also argued it as the reason for allowability over the prior art. Even if only the original claim is what has been “surrendered”, the claims in the reissue broaden even beyond that claim with respect to the fact that the reissue claims now only recite power management software, and the device driver limitations are not present. Therefore, the claims are broader in that respect. So, with regard to the first part of the test, appellant’s claim 51 is broader than claim 11.

Next, it is necessary to determine whether the broader aspect of the reissue claim is related to the surrendered subject matter. Appellant’s original claim was rejected over the prior art to Smith and Stewart which showed a system with device drivers monitoring devices and controlling power to them as noted in appellant’s brief pages 33-34. This rejection was overcome by adding the “virtual device driver limitation” to the claims. Therefore, the broadening removal of the device driver and virtual device driver limitations do broaden the claims in an aspect related to what was surrendered. The question then becomes whether or not the addition of power management software which controls power to configurable devices is a material narrowing which avoids recapture.

Appellant argues that power managing configurable devices is a material narrowing over the surrendered subject matter, and suggests that power management of configurable devices was germane to the prior art and the prior art rejection. Appellant points to the fact that the original claim 35 was not rejected as evidence that the configurability limitation is a patentable feature by itself. However, it is noted that claim 35 is a dependent claim. Claim 29 from which it depends already included the virtual device driver limitation which the examiner indicated as the

allowable feature, therefore no rejection would have or could have been made to the limitations contained in claim 35. The fact that such a limitation directed to configurability is contained in the original patent also would seem to indicate that this limitation was not overlooked by applicant in the original patent. Therefore, it is not clear that adding claims directed to this configurable limitation is really an error which can be corrected by reissue.

However, in any event, the question of "material narrowing" remains to be resolved. It is submitted that the presence of the configurable device limitation in reissue claim 51 is not a material narrowing of the surrendered subject matter with respect to the prior art rejection. The rejection was related to the use of a device driver for controlling power to devices. The reissue claims are broader in that respect as noted above. The fact that other limitations have been added that are not related to either the use of a device driver or virtual driver, that is to say, the addition of the limitation that the devices are configurable, is not a material narrowing germane to the prior art rejection. Clement dealt with a similar issue in that the claims had been broadened with respect to the surrendered subject matter but had other narrowing limitations added. There the court found that recapture did exist because on balance the claims were broader than they were narrower in a manner directly related to the subject matter surrendered throughout prosecution. Clement at 1167. The same sort of situation exists in the present case.

Similarly, the facts in Pannu also seem to mirror those in the present case. In the present case the addition of the configurable device limitations are not related to the use of a device driver for controlling power. **That is, the limitations are directed to aspects of the devices being controlled, not to the device driver which is performing the controlling.** In Pannu the court found that, "The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather to the positioning and dimensions of the snag resistant means." That court decided that this fact meant that, "The reissued claims were not

narrowed in any material respect compared with their broadening.” Such a statement also applies to reissue claim 51 in the present case in that the narrowing is with respect to the devices which are being controlled, not to the driver doing the controlling. Therefore, it is believed that impermissible recapture exists with respect to the claims contained in appellant’s Group I.

Issue 4. Does the recapture doctrine bar the claims of Group II (52,53,54,61)?

Appellant states that the configurable device arguments for Group I also apply to the claims in Group II. The arguments above rebutting appellant’s arguments for Group I therefore also apply to Group II.

Appellant also argues that the claims in Group II can stand on their own because they “recite limitations related to software operating at or as part of a kernel level of the operating system and/or in an operating system cooperative manner.” (Brief page 39)

Here again the question becomes one of whether or not these limitations represent a material narrowing that allows the claims to avoid recapture. It is submitted that, as in Clement, the claims are still broader than they are narrower in a manner directly pertinent to the surrendered subject matter. Here again just as in the case of the independent claim, these claims omit any sort of device driver limitation whatsoever and also do not recite the virtual device driver limitation. While the added limitations are some characteristics of the virtual driver, at least with respect to claims 52 and 54, these are not necessarily characteristics that only apply to virtual device drivers. They could also apply to other sorts of software.

With respect to claim 53, it includes the limitation of a plug and play device manager. This goes to the configurability limitations argued above with respect to claim 51. Plug and play does not narrow the subject matter with regard to what was surrendered in the original claims.

Claim 61 only further limits claim 53 to include limitations to virtual memory organization and multitasking. This also does not have any materially narrowing effect with respect to what was surrendered in the original claims, which was the use of device drivers to control power. Therefore, it is believed that impermissible recapture exists with respect to the claims contained in appellant's Group II.

Issue 5. Does the recapture doctrine bar the claims of Group III (58,88,90,91)?

Appellant states that the configurable device arguments for Group I also apply to the claims in Group III. The arguments above rebutting appellant's arguments for Group I therefore also apply to Group III.

Appellant also argues that the claims in Group III can stand on their own because they include limitations drawn to managing power on a system wide basis and use of multiple power states and that this is material to the prior art rejection because the prior art shows device drivers that control dedicated devices, and not the whole system.

Basically the same argument applies here again. These claims omit the device driver of the original claims and virtual device driver limitations added to overcome the prior art rejection. The fact that these new claims recite that the power management software controls power on a system wide basis does not overcome the fact that they are still broader than they are narrower in an aspect related to the prior art rejection. Power management software is a broader term. The fact that this software operates on a system wide basis does not make up for the fact that it is broader than the surrendered subject matter in this important aspect. Therefore, it is believed that impermissible recapture exists with respect to the claims contained in appellant's Group III.

Issue 6. Does the recapture doctrine bar the claims of Group IV (63)?

Appellant states that the configurable device arguments for Group I also apply to the claims in Group IV. The arguments above rebutting appellant's arguments for Group I therefore also apply to Group IV.

Appellant suggests that recapture cannot possibly exist with respect to claim 63 because it recites that the power management software lacks a permanent tie to a specific hardware device. Since this was one part of the reasons for allowance provided in the parent case appellant believes that it is a materially narrowing limitation.

However, in the allowed patent claims the examiner in that case said **that the fact that the virtual device driver is a device driver without a permanent tie to a specific hardware device is what made the claim allowable**. In reissue claim 63 the lack of a permanent tie is with respect to the power management software, not to a device driver or virtual device driver. While the limitation of a permanent tie to specific hardware is a narrowing limitation, the fact that the device driver limitation itself has been removed and replaced with the broader and more generic term power management software means that the claim has also been broadened in an aspect germane to the prior art rejection. Therefore it is submitted that the claim is still broader then it is narrower in an aspect related to the prior art rejection, and thus impermissible recapture still exists in the case of claim 63.

Issue 7. Does the recapture doctrine bar the claims of Group V (56,64-68,80-83,94)?

Appellant states that the configurable device arguments for Group I also apply to the claims in Group V. The arguments above rebutting appellant's arguments for Group I therefore also apply to Group V.

Here again appellant's arguments seem to hinge on the configurability aspect of the reissue claims.

As noted previously, however, the reissue claims lack any limitations drawn to device drivers as was present in the original claims or to the virtual device driver limitation added to make the claims allowable. As with Group I, the claims are broadened to only recite power management software. The original prior art rejection was directed to the use of device drivers for controlling power management. **The fact that the devices which are managed are configurable is not a materially narrowing limitation with respect to the prior art rejection.** Therefore, impermissible recapture does exist with regard to Group V.

Issue 8. Does the recapture doctrine bar the claims of Group VI (55,59,60,85)?

Appellant states that the configurable device arguments for Group I also apply to the claims in Group VI. No further arguments are presented.

The arguments above rebutting appellant's arguments for Group I therefore also apply to Group VI.

Appellant also argues that the reasons given for Groups II and V also separately apply to the claims in group VI. No further arguments are presented.

Therefore, the arguments above rebutting appellant's arguments for Groups II and V also apply to Group VI. Therefore, impermissible recapture does exist with regard to Group VI.

Issue 9. Does the recapture doctrine bar the claims of Group VII (69,84)?

Appellant states that the arguments for Groups I and V also apply to the claims in Group VII. No further arguments are presented.

The arguments above rebutting appellant's arguments for Groups I and V therefore also apply to Group VII. Therefore, impermissible recapture does exist with regard to Group VII.

Issue 10. Does the recapture doctrine bar the claims of Group VIII (70-72,79)?

Appellant states that the arguments for Groups I,II,V, and VI also apply to the claims in Group VIII. No further arguments are presented.

The arguments above rebutting appellant's arguments for Groups I,III,V, and VI therefore also apply to Group VIII. Therefore, impermissible recapture does exist with regard to Group VIII.

Issue 11. Does the recapture doctrine bar the claims of Group IX (74-78)?

Appellant states that the arguments for Groups I,III, and V also apply to the claims in Group IX. No further arguments are presented.

The arguments above rebutting appellant's arguments for Groups I,III, and V therefore also apply to Group IX. Therefore, impermissible recapture does exist with regard to Group IX.

Issue 12. Does the recapture doctrine bar the claims of Group X (92,93)?

Appellant states that the arguments for Groups I,II, and III also apply to the claims in Group X. No further arguments are presented.

The arguments above rebutting appellant's arguments for Groups I,II, and III therefore also apply to Group X. Therefore, impermissible recapture does exist with regard to Group X.

Issue 13. Does the recapture doctrine bar the claims of Group XI (73)?

Appellant states that the configurable device arguments for Group X also apply to the claims in Group XI. The arguments above rebutting appellant's arguments for Group X therefore also apply to Group XI.

Appellant also argues that the idle time settings made using a graphical user interface is a material narrowing of claim 73. However, as noted above, claim 73 is broader than the surrendered subject matter in that it recites management software and has eliminated the device driver limitations and the virtual device driver limitation added to overcome the prior art. The use of a graphical user interface to set idle times is in no way a material narrowing because it does not relate to the prior art rejection which rejected the claims directed to use of a device driver for managing power to devices. Therefore, impermissible recapture does exist with regard to Group XI.

Issue 14. Is the Judicially created recapture doctrine inherently and irreconcilably inconsistent with the Reissue Statute, 35 USC § 251, which permits broadening of claims, and now devoid of its original purpose of ensuring comity to the prosecution history reading public?

As noted above, this is really not an "issue" in itself to be decided here in this appeal. This is a legal argument best left to the courts.

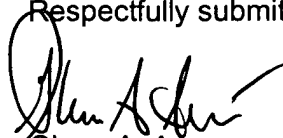
For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

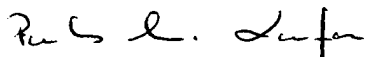


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Primary Examiner
Art Unit 2181

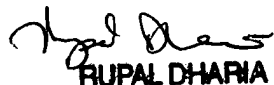
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February 4, 2003

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Appendix A – Final Rejection Paper No. 19

Office Action Summary

Application No.

09/224,620

Applicant(s)

MARISSETTY, SURESH K.

Examiner

Glenn A. Auve

Art Unit

2181

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 51-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 and 51-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Reissue Applications

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

While applicant has generally referred to "excess limitations" there is no indication as to what those excess limitations are. In identifying the error it is sufficient to identify a single word, phrase, or expression in the specification or an original claim, and how it renders the original patent to be wholly or partly inoperative or invalid. The declaration must specifically identify an error. (See MPEP § 1414)

Also, there is no new oath in the case to cover the amendments made on April 4, 2001.

2. Claims 1-35 and 51-94 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

3. Claims 51-94 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the

application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

As has been previously stated in this case, the newly presented reissue claims omit the "virtual device driver" limitation which applicant argued in the parent patent made the claims allowable. Applicant has gone to great lengths to argue that even if the omission of the "virtual device driver" limitation makes the claims broader in an aspect germane to the prior art rejection that the newly added limitations at the same time make the claims narrower in an aspect germane to the prior art rejection, and that because of this the recapture rule is avoided. However, the Federal Circuit in *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d 1597 (Fed. Cir. 2001) addressed a similar situation in which the limitation that was added during the prosecution of the original patent to make the claims allowable was omitted in the new reissue claims but those reissue claims also contained further limitations which Pannu argued narrowed the scope of the claims in a way related to what was surrendered. The court concluded that on reissue, Pannu was estopped from attempting to recapture the precise limitation he added to overcome the prior art rejections. The court also pointed to their decision in *Anderson v. Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed. Cir. 1998).

Taking claim 51 as an example, applicant has not only removed the "virtual device driver" limitation, but rather the "device driver" limitation itself is gone. Instead of having power management by the "virtual device driver", or as originally claimed in claim 11 the "device driver", applicant has included the limitation of "power management software" which is certainly broader than "device driver" or "virtual device driver". So, in this aspect germane to the prior art rejection applicant has certainly broadened the claim beyond not only the "virtual device driver" limitation which was argued as the reason why the claim was allowable over the prior art, but

has also broadened beyond the originally filed "device driver" for controlling the power management. Examining this situation in light of the court's decision in *Pannu*, applicant has broadened the claim with respect to the very aspect that made the claims allowable over the prior art, i.e. the virtual device driver controlling power management, while narrowing the claim in an aspect that is not material to the prior art rejection, i.e. the addition of the configurable device limitation. Therefore, the claim is not narrowed in any material respect compared with the broadening. As the court held in *Pannu*, applicant is estopped from attempting to recapture the precise limitation added to overcome the prior art rejection. The fact that applicant may have had other limitations that he could have added to overcome the prior art rejection does not bar a recapture rejection.

With respect to the other independent reissue claims applicant also argues that the various configurability and reconfigurable aspects of the claims are narrowing limitations that are somehow material. However the analysis above also applies to the other independent claims as well. Applicant has broadened the reissue claims by eliminating the precise limitation that he argued made them allowable, while adding limitations that are not material to the prior art rejection.

The dependent reissue claims also fail to include the virtual device driver limitations and thus are also rejected for recapture as it applies to the claims on which they depend.

Applicant alternatively argues that the claims are directed to a totally different invention and these are the "overlooked" aspects that were not originally claimed. Applicant states that the configurable aspect was overlooked and that this ability to manage power to configurable devices is what makes at least claim 51 narrower than the original claims. However, the configurable aspect was present in the original patent at least in claim 35. Therefore the argument that this aspect was overlooked seems to be untrue. Since this aspect was not in fact

overlooked in the original patent, even if it were to be found to be materially narrowing, it does not bar a recapture rejection.

Response to Arguments

4. Applicant's arguments filed February 26, 2002, have been fully considered but they are not persuasive.

Applicant has not made any arguments with respect to the rejections of the claims based on a defective reissue oath or declaration nor has any new oath or declaration been provided.

Applicant does argue that adding the term "virtual" in the prosecution of the parent case amounted to merely adding a name to the device driver and that it is not the addition of any structural element and that this addition only implicitly added limitations specifying the characteristics of the power management software by specifying that it be a virtual device driver. However applicant then goes on to give the definition of what a virtual device driver is. Such a limitation does indeed add certain specific characteristics to the device driver term and as such narrows the limitation. Applicant's reissue claims then remove this narrowing limitation which was relied upon in the parent patent for patentability of the claims. This would appear to be the definition of recapture. As noted above, applicant is now attempting to claim only "power management software" which not only has removed the virtual device driver limitation but has also removed the device driver limitation altogether. Applicant's definition of "virtual device driver" includes the device driver running at the privileged ring 0 protected mode of the microprocessor. However, the claims do not include such a limitation, so the argument that applicant is merely using different terms to claim the same thing is not at all persuasive. Applicant argues that there would be no recapture if the virtual device driver term had been

replaced by its definition; however, applicant has not replaced the term with its definition, so certainly recapture can and in this case does exist.

Applicant argues that he has added limitations related to running at the privileged ring 0 protected mode of the microprocessor. However, claim 51, for example, contains no such limitation. Therefore this argument is also not persuasive.

Applicant goes on to argue that limitations added which supervise the power management of devices by the power management software are directly and closely related to the omitted virtual device driver limitation. However, as noted above, even if these limitations were considered to be part of the definition of the virtual device driver, they are not its entire definition. They omit at least the operating the device driver in ring 0 protected mode aspects of the definition. Furthermore, the entire device driver limitation itself has been removed and now only power management software is recited. Such software does not necessarily include a device driver at all. Thus the limitation that was expressly added to the claims in the patent to make them allowable over the prior art, the virtual device driver, has been eliminated from the claims in the reissue application. Such a broadening of the claims violates the recapture rule. Applicant's use of parts of the definition of a virtual device driver, but not all of it, means that the claims have been broadened beyond this limitation's meaning.

Applicant also argues that the certain claim limitations have been added that are related in some way to the definition of the virtual device driver limitation and that because they are so related that recapture is somehow avoided. However as noted above, even though the claims may include some limitations that are in some part of the definition of the virtual device driver, they are not its complete definition. This limitation was added in the patent in order to make the claims allowable. Any broadening of the claims beyond this limitation which was added to make the claims allowable violates the recapture rule. Applicant seems to admit in his arguments that

the claims have been broadened at least somewhat beyond the virtual device driver limitation but that they are in some way related to the definition of the virtual device driver and that thus they somehow avoid recapture. As noted above, the Court in Pannu explicitly stated that on reissue applicant is estopped from attempting to recapture the precise limitation he added to overcome the prior art rejection. That is what applicant is attempting to do in this case. Including only certain parts of what makes a virtual device driver a virtual device driver amounts to broadening the claim in an aspect directly related to that which was added to make the claims allowable in the patent.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn A. Auve whose telephone number is (703) 305-9638. The examiner can normally be reached on M-F (8:00 - 5:30) First Friday Off.

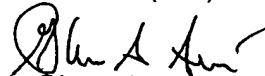
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Wong can be reached on (703) 305-3477. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Glenn A. Auve
Primary Examiner
Art Unit 2181

gaa
March 30, 2002